

REMARKS

This Amendment is submitted in connection with a Request for Continued Examination (RCE). The pending claims are 1-16, 19-32, 34-40, and 42-44. Favorable reconsideration of the application is respectfully requested.

Applicant acknowledges the telephone discussion with Applicant's attorney Charles F. Charpie, III on December 10, 2007. During the discussion, the examiner indicated the Amendment After Final Rejection dated November 13, 2007 was admitted, but was not persuasive. At the conclusion of the discussion, Applicant's attorney indicated an RCE would be submitted.

In an Office Action dated August 8, 2007, the Examiner finally rejected independent Claims 1 and 31 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,578,363 to Finley et. al (hereinafter, "Finley") in view of U.S. Patent No. 4,464,428 to Ebert (hereinafter, "Ebert"). The Examiner asserts that Finley discloses all of the limitations of Applicant's independent Claims 1 and 31 with the exception of the characteristics of a foam layer.

To overcome the deficiency in Finley, the Examiner relies on Ebert. The Examiner asserts the Ebert reference discloses a closed cell foamed material which is useful in the building construction industry for sound attenuation. The Examiner asserts that it would have been obvious to modify the insulating foam layer of Finley to be as disclosed by Ebert.

However, the combination of the Finley and Ebert references does not meet all of the limitations of Applicant's independent Claims 1 and 31. The combination of the Finley and Ebert references fails to disclose an acoustic layer including a plurality of discrete beads of substantially elastic, resilient material wherein portions of adjacent beads abut one another and other portions of said adjacent beads are spaced from each other to create spaces therebetween and wherein substantially all of said adjacent beads are integrally joined together at the abutting portions thereof. In contrast, the Ebert reference discloses a closed cell foamed material of polypropylene or polyethylene having interior canals sliced through the foam cells (Column 5, Lines 5-7).

To establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143. The combination of Findley and Ebert does not teach all the claim limitations. The combination does not include a structure where portions of adjacent beads are spaced from each other to create spaces therebetween. Therefore, a prima facie case of obviousness has not been established.

On Page 3 of the Office Action dated August 8, 2007, the Examiner further stated that the claim limitation of spacing between portions of the beads is an inherent property of a closed cell foam. Applicant respectfully disagrees.

A reading of Ebert shows that a closed cell foamed material is a densely-packed material with low permeability to heat, moisture and sound. The properties of the closed cell foam that Ebert discusses are contrary to the Examiner's claim that an inherent property of a closed cell foam includes "portions of said adjacent beads are spaced from each other to create spaces." In discussing closed cell foamed material, Ebert states that "these webs of foamed material exhibit the disadvantage of possessing low permeability to heat, moisture and sound." Ebert, column 1, lines 24-25. Ebert teaches a method of increasing the permeability of closed cell foam material. Ebert states that the difficulty in increasing the permeability of the closed cell foamed material exists because "[e]ven where it is possible to arrange that the web of foamed material originally contain alterations designed to improve these properties, the application of heat and pressure in forming the finished web results in a densification of the pore structure which frequently disadvantageously affects the originally set properties." Ebert, column 1, lines 30-36. Two properties of the closed cell foam that Ebert discusses, first, the exhibited low permeability to heat, moisture and sound and second, the densification of the pore structure, are contrary to the Examiner's claim that an inherent property of a closed cell foam includes "portions of said adjacent beads are spaced from each other to create spaces." A foam in which portions of said adjacent beads are spaced from each other to create spaces therebetween would not possess a low permeability to moisture, and would not have a

dense pore structure. As Ebert clearly shows, a closed cell foam is a densely-packed material with low permeability to heat, moisture and sound.

To establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143. Since the combination of Findley and Ebert does not teach all the claim limitations in Applicant's independent Claims 1 and 31, a prima facie case of obviousness has not been established. The Examiner's statement regarding the supposed inherent property of closed cell foams is unsupported. The cited Ebert reference fails to teach spaces between the beads. The examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. MPEP § 2112. The Examiner must provide a reason why a person skilled in the art would incorporate the alleged inherent property into the combination of Finley and Ebert. To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Id. Thus, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. § 103(a) of independent Claims 1 and 31.

Claims 2-16 and 19-30 are dependent upon independent Claim 1 and for at least this reason, are also patentable.

Claims 34-40 and 42-44 are dependent upon independent Claim 31 and for at least this reason, are also patentable.

In the event the Examiner does not find the arguments presented above sufficiently persuasive to show that the present claims are patentable, Applicant is supplying a Declaration with additional evidence as to patentability. The Declaration, executed by Mr. Dan Sawyer, states that the Brock acoustic flooring layer is made of a plurality of discrete beads of substantially elastic, resilient material wherein portions of adjacent beads abut one another and other portions of the adjacent beads are spaced apart from each other to create spaces therebetween. Mr. Sawyers, Chief Executive Officer of Brock USA, was involved in the development of improved materials for use

in multi-layer flooring composites. Mr. Sawyers further states the Brock acoustic flooring layer is distinctly different from the material commonly used in the construction industry. The fact that there are spaces created between adjacent beads provides the acoustic flooring layer with low weight, flexibility and excellent sound attenuation. The spaces also create a vibration and acoustic transfer break between the top surface and the sub-floor surface.

As a result of the discrete beads of substantially elastic, resilient material wherein portions of adjacent beads abut one another and other portions of the adjacent beads are spaced apart from each other to create spaces therebetween, rolls of the Brock lightweight and flexible acoustic flooring layer displace a heavy, rigid board. Mr. Sawyer further states that, because of the characteristics of the acoustic layer, people did not expect it work well for floor underlayment.

Mr. Sawyer states that the Brock acoustic flooring layer has received significant commercial success, far surpassing expectations. Mr. Sawyer indicates that the commercial success of the Brock acoustic layer is the result of the attributes of the product, and not advertising or marketing efforts. Further, Mr. Sawyer states that the Brock acoustic layer is not advertised, but the product has obtained approximately one percent market share in two years.

In view of the above amendments and remarks, Applicant has shown that the specification is in proper form, the claims are in proper form for allowance, and the claims are neither disclosed nor suggested by the references of record. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the objections and rejections of record, and allowance of all claims.